I.

The Questions Presented by Petitioner Are Real and They Should Be Resolved at This Time.

At pages 4-5 respondents assert that the "Questions Presented" are non-existent because the Ninth Circuit followed the guidelines established by this Court.

The Ninth Circuit merely followed its interpretation (which does not comport with that of other Circuits) of the broad guidelines enumerated by this Court in the context of inventions that reduced to bits and pieces. Where the invention involves a complete method or device employing bits and pieces that are admittedly old, an analysis that does not go beyond a consideration of the bits and pieces merely confirms what is already admitted. Other criteria indicative of obviousness or non-obviousness, such as the extent of the departure from the prior art approaches to the problem, the solution of a long-felt want, commercial success, and skepticism of those skilled in the art, are of controlling importance. However, the Ninth Circuit routinely finds structural obviousness and invalidity where all of the elements are old, and it refuses to consider whether the invention as a whole was obvious and gives little or no weight to criteria indicating non-obviousness of the invention as a whole.

This Court has not established guidelines specifically applicable to inventions that must be analyzed as a whole under the 1952 Act. As pointed out in Bada's petition, the Courts of Appeal in the various circuits are interpreting the broad guidelines differently, and guidance from this Court is required in order to achieve uniformity.

Respondents have not in any way discussed the conflict that exists because the Ninth Circuit doesn't go beyond the bits and pieces while other Circuit Courts look to the invention as a whole. Their arguments support the Ninth Circuit tests. Apparently, it is their position that the Ninth Circuit test is the proper one and other tests are incorrect.

With reference to descriptiveness, this Court has not established any guidelines under the Trademark Act of 1946, and hence there is no support for respondents' contention that the Ninth Circuit merely followed guidelines established by this Court.

II.

In Their Endeavor to Support the Piecemeal Analysis of the Bits and Pieces by the Ninth Circuit, Respondents State Many Facts Incorrectly in an Attempt to Avoid an Evaluation of the Inventions and Trademarks as a Whole.

A. The Method Patent.

> Respondents assert on page 4 that the basis for the decision on non-obviousness by the Patent Office Board of Appeals was refuted by the evidence developed at the trial.

Respondents assert that the basis for the decision of the Board of Appeals was failure of the prior art to include the step of transposing one weight of each pair to the opposite side of the wheel, and that this feature was not in the prior art before the Patent Office Board of Appeals. However, this feature was in the prior art before the Board of Appeals. It is shown in the prior art patent to Lowe and also in the prior art patent to Holl. The Examiner in the Patent Office rejected Bada's

claims on the patents to Booth and Lowe. The Board of Appeals analyzed the Lowe patent and each of the other prior art patents as a whole to ascertain the prior art approaches to static wheel balancing and it concluded that when so analyzed it would not be obvious to one skilled in the art to incorporate the teaching of Lowe in order to achieve the patented method. It stated:

> "We find in Lowe a disclosure of dynamically testing an automobile wheel for unbalance of both the static and dynamic type and counterbalancing any unbalance by the addition of equal weights to the opposite side of the wheel. However, we find disclosed the use of only two weights to attain the counterbalance and such weights are applied directly at the points of maximum effectiveness, as determined by the testing equipment. Consequently, we are not convinced that one of ordinary skill in the art would find in the Lowe disclosure the suggestion of modifying the Booth method by the use, manipulation and attachment of four weights in the manner recited in the instant claims." (A. 46).

The Board of Appeals found that combining the old steps in accordance with the patented method would not have been obvious to one of ordinary skill in the art in view of the many different approaches to the overall problem shown by the prior art.

It is submitted that the reason for the differences in opinion between the Board of Appeals and the Ninth Circuit is that the Board concluded, after an analysis of the prior art as a whole, that the invention as a whole would not have been obvious to one skilled in the art if he inspected the prior art, because the approaches to the problem by the prior art were signifi-

cantly different from Bada's approach, whereas the Ninth Circuit concluded that it would have been obvious because all of the bits and pieces were available in the prior art. One looked at the forest and found non-obviousness, and the other looked at the trees and found obviousness *per se*.

> Respondents further assert on page 8 that the Ninth Circuit recognized that Holl and Lowe both disclose the division of weights and the attachment of one of each pair to the opposite rim, while the Patent Office Board of Appeals wholly failed to see this.

The Board of Appeals did see this. It stated:

> "We find in Lowe . . . the addition of equal weights to the opposite sides of the wheel." (A. 46).

Holl supplied the divided weights at the points of maximum effectiveness, like Lowe. The Board's reasoning is equally applicable to Holl.

> Respondents assert on page 5 that all that is involved is the manipulation of four pieces of lead.

This characterization of the patented method is so generalized that it is misleading. What is actually involved are seven procedural steps, as set forth in Claim 1 (D. 50).

Such an oversimplification attempts to obscure the merits of the invention and the effort that was required to find out how the weights should be manipulated. This included:

> "Two years of scientific research, a project conducted under the direction of Dr. Harold Lurie of

the California Institute of Technology, Pasadena, California."

. . .

"This instrumentation phase required five and a half months of intensive effort. This was followed by actual road-testing under scientifically-observed conditions, and the scientific recording of the experienced phenomena on the special-purpose electronic recording instruments, and then expert interpretation of the recorded phenomena." [Ex 30, R.T. 233-237].

Respondents assert on page 7 that the only result provided by the method patent is a balanced wheel.

Such a generalization obscures the real issues, such as how well the wheel is balanced, how much time and money are required and, most importantly, whether the invention as a whole was obvious.

With reference to the results of the method patent, the evidence shows:

a. Comparative tests conducted for Firestone when the Bada system was first introduced showed that the balance achieved by the Bada system was different from the balance achieved by other systems then in use [R.T. 717-718].

b. Respondents' expert witness testified that he found that the Bada system and a conventional spin-balancing system achieved a different balance, and he concluded that "The dynamically [spin] balanced wheel seemed to be a little less smooth than the statically [Bada] balanced wheel" [R.T. 825].

c. Wheels can be balanced by the Bada system in a small fraction of the time required by

other systems used commercially (one or two minutes versus fifteen minutes), and the balancing procedure can be taught to unskilled workers in ten minutes [R.T. 194].

d. The Bada method eliminates the large amount of guesswork and trial and error involved in other methods [Ex. X, p. 53].

e. The Bada method requires only three sizes of weights, whereas other methods require that about 12 or more sizes be available in stock. [Ex. X, p. 53].

Respondents assert on page 7 that petitioner's item (e)—that there was much confusion in the trade concerning how to go about static wheel balancing—is not supported by the record.

There is ample support in the record for petitioners' assertion and consequently respondents' statement is unsupportable. The record shows that there was much confusion and that Bada's method for static wheel balancing was revolutionary and was adopted over or replaced the other methods.

Firestone at the outset of Bada's program had no faith in static wheel balancing of any kind [R.T. 715].

Booth [Ex. Z, British Patent 731,459] uses a horizontal balance. He teaches the use of one or more balancing weights and that they be moved to achieve balance. Thus, the number of weights and the way they are moved are determined by trial and error. Also, the weights are affixed to only one side of the wheel and that alters the dynamic balance of the wheel (*i.e.*, the rotational balance).

Hume [Ex. Z, U.S. Patent 2,052,295] teaches balancing by rotating a wheel in a vertical plane to ascertain the light spot and movement of two weights on either side of the light spot to achieve balance. Ascertainment of balance by rotating a wheel in a vertical plane is prohibitively slow because of trial and error.

Morse [Ex. Z, U.S. Patent 2,136,633] teaches horizontal balancing where one weight is first employed and if this is insufficient, a second weight is added and the weights are shifted circumferentially in opposite directions to cause balance. This involves trial and error.

Lowe [Ex. Z, U.S. Patent 2,700,892] teaches use of a vertical spin type balancer with balancing weights being placed on each side of the wheel at the light spot. This is the conventional spin type balancing method which requires use of many sizes (12 to 20) of weights in order to achieve balance.

Holl [Ex. Z, U.S. Patent 2,592,804] teaches horizontal static balancing where balancing weights are placed at the light spot to achieve balance and half of the weight is placed on each side of the wheel. This requires a large number of weight sizes.

Dapper [Ex. 20] employed horizontal balancing and taught the use of nine sizes of weights, with the weights being positioned 120° apart on the wheel on either side of the light spot and being placed on each side of the wheel. The 120° spacing requires the ultimate use of more weight than is necessary.

Challenger [Ex. M] employed horizontal balancing and taught use of a single weight at the light spot if less than three ounces are reqtiired. If more is required,

then twice as much weight as needed is placed at the light spot and the weights are then positioned 120° apart on the wheel with the weights being attached to each side of the wheel.

Moweko [Ex. L] employed horizontal balancing and teaches positioning weights 120° apart on the wheel and placing one-half of the weight on each side.

Speedmaster [Exs. K, O] employed horizontal balancing and teaches the use of spaced weights of unspecified number to compensate for the spread of the unbalanced rubber on the tire. It employs twelve sizes of weights, and the weight is divided between the inner and outer side of the wheel.

Thus, the record shows that there were numerous versions of static wheel balancing. Firestone had no confidence in any of them until Bada conducted exhaustive tests which caused Firestone to change to the Bada system [R.T. 719].

All of the prior art methods for static balancing are distinctively different from Bada's method. They go off in many directions, and none was successful. Although they disclose the bits and pieces that make up the Bada method, they do not disclose, or even come close to suggesting, Bada's method as a whole.

> Respondents also assert on page 7 that everyone's commercial success was the result of Vernon Dapper's unique idea of having wheels balanced whenever new tires were bought.

Having wheels balanced whenever new tires were bought predates Dapper's entry into the wheel balancing business. He entered the business in 1950, and

used that as part of his sales pitch at that time [R.T. 556-557]. However, those early activities were not very successful, and it was not until the patented method was introduced in 1956 that commercial success was evident [Ex. 34].

B. The Balancer Patent.

> Respondents assert on page 8 that the only novelty claimed for the balancer patent was the addition of a cam and spring arrangement to the old balancer.

The automatic-off feature was first incorporated in a completely new balancer designed by Bada. The patent application for the new balancer was filed on December 8, 1959 [Ex. 3].

Respondents' assertions concerning the addition of a cam and spring to the old balancer refers to Bada's earlier design which is shown in patent No. 2,909,063 which issued October 20, 1959 [Ex. AA]. Respondents' assertions are based upon conjecture, and not upon fact, because the cam and spring were never added to the old balancer. In fact, the addition of the cam and spring to the old balancer would render it inoperative, as set forth in detail at pages 24-29 of the "Brief for Plaintiff-Appellant" before the Ninth Circuit which is in Volume One of the record before this Court.

The novelty claimed for the balancer patent is illustrated by claim 1 (D. 50) which recites seven interrelated elements.

The Patent Office analyzed the invention on the basis of the overall combination—*i.e.*, the invention as a whole. It cited as prior art the old balancer of Bada's

patent No. 2,909,063, but none of the claims was rejected on the basis of the old balancer [Ex. Y]. The old balancer was cited for the purpose of information only, and not for the purpose of rejection [Ex. Y, p. 30]. The Patent Office could not properly have rejected claims such as claim 1 on the basis of the old balancer because as part of the overall combination this claim requires a pedestal movably carried within the support sleeve, whereas the old balancer employs a fixed pedestal 18 [Ex. AA].

Thus, the novelty claimed for the balancer is a new combination of seven interrelated elements which function in a manner different from the prior art to produce a new result. This is not the mere addition of a cam and spring to an old balancer as Respondent asserts and as the Ninth Circuit stated as a foundation for its finding of invalidity (426 F. 2d 8, 10).

> Respondents assert on page 7 that the only result provided by the balancer patent is that it moves from "on" to "off" when desired.

This is another oversimplification that attempts to obscure the merits of the invention. With reference to the results of the balancer patent, the evidence shows:

a. The prior art shows balancers in which the operator must do something in order to turn the balancer off. In Holl the operator must unlatch a lever [Ex. AA].

b. A balancer is likely to be damaged if turning it off is under the control of the operator [R.T. 351-355].

c. The Bada balancer turns off automatically when the weight of a wheel is removed, thereby

eliminating the possibility of damage due to operator error [Ex. 3].

d. The automatic-off feature was given prominence in respondents' sales literature as being an advantageous result [Ex. 7 to Ex. 93].

Thus, the inventions of both patents produce new results over and above the generalized result described by respondents, and these results show the innovation that the patent laws are designed to promote.

> Respondents assert on page 8 that there was unanimous testimony of the patentee, his expert, and the opposing expert to the effect that adding a spring to the prior art balancer made by Bada would provide the patented "off-on" feature.

As noted above, it is physically impossible to add a spring and cam to the prior art balancer to produce Bada's new balancer. Further, the testimony was unanimously equivocal and totally lacking in support of respondents' assertions.

The patentee testified:

> "Well, I am not sure. I think so. Well, I can't answer that definitely without testing. It is possible." [R.T. 547].

Bada's expert testified:

> "You may be able to but it wouldn't—the way to design it, you have to design the spring and the cam with a combined system." [R.T. 687].

Respondents' expert testified:

> "Well, not having a set of working drawings it is a little difficult to answer that positively, but certainly it would appear so." [R.T. 900].

Adding a spring to the prior art balancer made by Bada was never tried. Everything on that argument is based upon conjecture, not fact.

C. The Trademarks.

> Respondents assert on pages 3 and 9 that extremely small is a virtue petitioner claims for its weights and that "Micro" describes them.

Petitioner does not claim that its weights are either small or extremely small. That would be an absurdity for weights that are one, two, and four inches long. Petitioner claims that its system provides accurate balancing with only three weight sizes, and that balance is achieved by starting with the smallest of the three weight sizes so that the lightest weights that can accomplish the balance are employed. [Ex. 30].

> Respondents assert on page 9 that none of the defendants except Montgomery Ward are accused of using the trademark "MICRO-PRECISION".

This generalization attempts to render obscure the fact that Bada's major claim for trademark infringement is against Montgomery Ward, as set forth on pages 63-73 of the "Brief for Plaintiff-Appellant" before the Ninth Circuit which is in Volume 1 of the record before this Court.

Conclusion.

Respondents have ignored the divergence in the tests employed by the different Courts of Appeal. They have focused upon the bits and pieces in the same manner that the Ninth Circuit did, rather than upon the inventions and trademarks as a whole as required by the patent and trademark laws. They have stated many facts incorrectly, in an attempt to reduce Bada's inventions and trademarks to piecemeal analysis.

The questions presented in Bada's petition are concerned with important problems of immediate national concern which should be resolved by this Court in order to carry out the public policy expressed in the patent and trademark laws and in order to achieve uniformity in the administration and application of those laws.

We respectfully submit that Bada's Petition For a Writ of Certiorari should be granted.

Dated: October 5, 1970.

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